

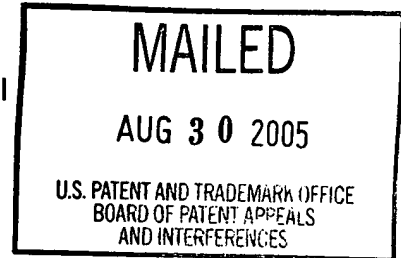
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte D. WADE WALKE
and NATHANIEL L. WILGANOWSKI

Appeal No. 2005-2030
Application No. 09/783,669



ORDER UNDER 37 CFR § 41.50(d)

Before WILLIAM F. SMITH, ADAMS and GRIMES, Administrative Patent Judges.
GRIMES, Administrative Patent Judge.

ORDER UNDER 37 CFR § 41.50(d)

Under the provisions of 37 CFR § 41.50(d),¹ we require Appellants to address the following matters:

We invite attention to commonly assigned Application No. 09/714,882.² That application was the subject of an appeal to this board (Appeal No. 2004-1732), which was decided on September 24, 2004.

The issues and arguments in Appeal No. 2004-1732 bear close resemblance to those in this appeal. In Appeal No. 2004-1732, the broadest independent claim (claim

¹ "The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such an order." 37 CFR § 41.50(d).

² The named inventors in the instant application are D. Wade Walke and Nathaniel L. Wilganowski. In Application No. 09/714,882, the inventors are C. Alexander Turner Jr., Michael C. Nehls, Glenn Friedrich,

2) was directed to “[a]n isolated nucleic acid molecule comprising a nucleotide sequence that encodes the amino acid sequence shown in SEQ ID NO:2.” The polypeptide of SEQ ID NO:2 was disclosed to have sequence similarity to Notch receptor ligands, but the specification did not disclose the biological function of the putative ligand. The only issue in Appeal No. 2004-1732 was whether the specification disclosed a patentable utility for the claimed invention.

In Appeal No. 2004-1732, the appellants argued, among other things, that the claimed nucleic acids had utility because they could be used in methods that do not depend on the biological activity of the encoded protein. The appellants argued that the claimed nucleic acids were useful “in determining the genomic structure of the corresponding human chromosome . . . , for example mapping the protein encoding regions” and that they “are useful for functionally defining exon splice-junctions.” Application No. 09/714,882, Board decision mailed 9/24/04, page 18.

The appellants in Appeal No. 2004-1732 also argued that the claimed nucleic acids could be used in “gene chips” or “DNA chips” to monitor gene expression. The appellants argued that “[s]uch “DNA chips” clearly have utility, as evidenced by hundreds of issued U.S. Patents. . . . Clearly, compositions that enhance the utility of such DNA gene chips, such as the presently claimed sequences encoding a testis specific Notch ligand, must in themselves be useful.” Id.

Finally, the appellants argued that the claimed polynucleotides were useful because of a disclosed polymorphic position in SEQ ID NO:1: “the skilled artisan would readily recognize and easily believe that the presently described polymorphic markers [sic] could be useful in forensic analysis. The fact that forensic biologists use

polymorphic markers such as those described by Appellants every day provides more than ample support for the assertion that forensic biologists would also be able to use the specific polymorphic markers [sic] described by Appellants in the same fashion.” Id., page 16.

The panel that decided Appeal No. 2004-1732 reviewed governing principles of law; addressed and rejected the appellants’ arguments premised on DNA chips, gene mapping, and exon splice junctions; and concluded that “Appellants’ disclosure in th[at] case does not provide a specific benefit in currently available form, and therefore lacks the substantial utility required by 35 U.S.C. § 101.” Id., page 27. Accordingly, the examiner’s decision, rejecting all of the pending claims in Application No. 09/714,882, was affirmed.

As in Application No. 09/714,882, in this appeal claims 2-4 are directed to “[a]n expression vector comprising a nucleic acid sequence encoding the amino acid sequence shown in” the specification’s SEQ ID NOs 4, 2, and 6, respectively. These three sequences are “apparently encoded within a single coding exon (which may include one or more introns that can be spliced-out in certain cells or tissues).” Specification, page 6. The claimed nucleic acids are disclosed to encode G-protein coupled receptors (GPCRs) that “span the cellular membrane and are involved in signal transduction after ligand binding.” Page 2. The specification, however, does not disclose the biological activity or function of the polypeptides of SEQ ID NOs 2, 4, and 6. The only issue in this appeal is whether the specification discloses a patentable utility for the claimed invention. Examiner’s Answer, page 3.

The Appeal Brief in this appeal includes essentially the same arguments that were made and rejected by the previous merits panel in Appeal No. 2004-1732.³ For example, Appellants argue that:

- “Clearly, the present polynucleotide provides exquisite specificity in localizing the specific region of the human chromosome containing the gene encoding [sic, comprising?] the given polynucleotide. . . . The presently claimed polynucleotide sequence defines a biologically validated sequence that provides a unique and specific resource for mapping the genome.” (Appeal Brief, pages 15-16);
- “[T]he described sequences are useful for functionally defining exon splice-junctions.” (id.);
- “[T]he present nucleotide sequence would be an ideal, novel candidate for assessing gene expression using, for example, DNA chips. . . . Such ‘DNA chips’ clearly have utility, as evidenced by hundreds of issued U.S. Patents. . . . Clearly, compositions that enhance the utility of such DNA gene chips, such as the presently claimed sequences encoding a G protein-coupled receptor, MRGX2, which Appellants have shown are potential drug targets for pain and other neurological disorders, among others, must in themselves be useful.” (id., page 12);

On these facts, we require Appellants to explain why we should again address the same line of argument in this case: since the same arguments were considered and thoroughly addressed in Appeal No. 2004-1732, why would the previous panel’s treatment of those arguments not be dispositive here? In particular, why should the facts and arguments set forth in the briefing of this appeal lead to a different conclusion than that reached by the panel in Appeal No. 2004-1732, which rejected the same arguments? We note that, according to PTO records, the appellants in Appeal No.

³ In addition to the arguments quoted above, Appellants cite three U.S. Patents. According to Appellants, “[t]he issuance of these U.S. patents clearly indicates that G protein-coupled receptor polynucleotides have utility and that such utilities were sufficiently specific and substantial to warrant the issuance of U.S. patents directed to methods used to identify and characterize G protein-coupled receptors.” Appeal Brief, page 5. We disagree. Appellants have presented no evidence comparing the protein(s) encoded by the presently claimed nucleic acids to the protein(s) of the cited patents. The mere fact that some GPCRs have been shown to have patentable utility does not mean that all GPCRs do, even without disclosure of their specific function or activity. We have reviewed the cited patents but do not find that they show any practical utility for the presently claimed products.

2004-1732 (Application No. 09/714,882) did not request rehearing under 37 CFR § 41.52 or appeal the Board's decision; the application has been abandoned.

Conclusion

In conclusion, we require Appellants to address the foregoing matters "consider[ed] to be of assistance in reaching a reasoned decision on the pending appeal." 37 CFR § 41.50(d). We caution, however, that this is not an invitation to expand on points raised in the Appellants' brief or to rehash arguments already set forth in the brief. This is not an invitation to raise arguments or issues on appeal, or to collaterally attack the decision in Appeal No. 2004-1732. See 37 CFR § 41.37(c)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown"). Appellants' response should be confined to the matters outlined above.

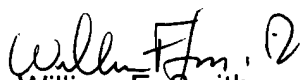
Time Period For Response

A period of one month from the date of this order is set for Appellants' response.

This time is non-extendable.

Failure to respond in a timely manner will result in dismissal of the appeal.

37 CFR § 41.50(d)



William F. Smith
Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge



Eric Grimes
Administrative Patent Judge

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